

**REMARKS**

**Summary Of The Office Action & Formalities**

Claims 17-29 are all the claims pending in the application. By this Amendment, Applicant is amending claims 17, 24, and 27, and canceling claim 23. No new matter is added.

Applicant thanks the Examiner for initialing the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on August 27, 2003.

The Examiner has checked the first box for item 10 on form PTOL-326, but has not completed item 10 to indicate whether the drawings are acceptable or objected to. The Examiner is kindly requested to clarify this omission.

The Examiner has withdrawn the previous prior art rejections in view of Applicant's last response, but now rejects the claims as follows:

1. Claims 17, 19, 20, 21, 22, 23, 25, 27, 28, and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Popat (USP 5,997,683)<sup>1</sup> in view of Stewart (US 6,030,134).

2. Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Popat (USP 5,853,837) in view of Stewart (US 6,030,134) as applied to claims 17, 19, 20, 21, 22, 23, 25, 27, 28, and 29 above, and further in view of Shingu et al. (US 5,824,178).

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<sup>1</sup> The Examiner references U.S. Patent 5,997,683 in the rejection and appears to rely on portions of the disclosure in this patent to reject the claims. However, based on certain parts of the Examiner's rejection, and in particular the rejection of claim 23 at page 2 that identifies reference numerals 108 and 208 which do not appear in the '683 patent. Applicant believes the Examiner intended to rely on U.S. Patent No. 5,853,837 as well as (or instead of) U.S. Patent 5,997,683. Applicant also notes that both U.S. Patent 5,997,683 and on U.S. Patent No. 5,853,837 are both issued to Popat. Accordingly, the Examiner is kindly requested to clarify which patent reference(s) forms the basis of the prior art rejection and to issue a new Office Action identifying the correct patent(s) if the current rejection includes an error.

3. Claims 24 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Popat (USP 5,853,837) in view of Stewart (US 6,030,134) as applied to claims 17, 19, 20, 21, 22, 23, 25, 27, 28, and 29 above, and further in view of Bishop et al. (US 5,571,587).

Applicants respectfully traverse.

**Claim Rejections - 35 U.S.C. § 103**

1. *Claims 17, 19, 20, 21, 22, 23, 25, 27, 28, And 29 In View Of Popat '683 Or Popat '837 And Stewart..*

In rejecting claims 17, 19, 20, 21, 22, 23, 25, 27, 28, and 29 in view of Popat '683 or Popat '837 and Stewart, the grounds of rejection acknowledge that "Popat teaches all the claimed requirements except for the step of nipping the printing paper at substantially spaced apart locations." Office Action at page 3. However, the grounds of rejection go on to state:

Stewart teaches a printer similar to that of Pop at as illustrated in Figure 5, Stewart teaches the step of nipping printing paper 18 at substantially spaced apart locations. To one of ordinary skill in the art, it would have been obvious to use the feeding method of Stewart in the a method of Popat, in order to avoid adversely impinging on the printing portion, as taught in the Abstract of Stewart.

Office Action at page 3.

As set forth in the Manual Of Patent Examining Procedure ("MPEP"):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP at Section 2143 (emphasis added). Applicant submits that the grounds of rejection do not satisfy at least the first criteria that the prior art provide some suggestion or motivation to make the alleged modification. As the Federal Circuit reminded us, the USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In Lee*, USPQ2d 1430, 1433 (Fed. Cir. 2002), *citing, e.g., In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”).

The Federal Circuit goes on to emphasize that the “need for specificity pervades this authority.” *In re Lee* at 1433 (emphasis added) (*citing In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”)).

Applicant respectfully submits that the current grounds of rejection do not satisfy the Federal Circuit’s rigorous standard for demonstrating that the claimed invention would have been obvious in view of the combination of Popat ‘683 or Popat ‘837 in view of Stewart.

In fact, rather than teach or suggest to one skilled in the art to modify the printing method disclosed by Popat ‘683 or Popat ‘837 as set forth in the grounds of rejection, Stewart would *lead away* from such a modification. That is, Stewart at most would teach the skilled artisan to remove or withdraw the central rollers (*i.e.*, A<sub>2</sub>-A<sub>4</sub>) only in the case of edible paper, and certainly

not in the case where one uses paper for printing business cards or labels as disclosed in Popat '837 and Popat '683.

Consider, first, that Stewart relates to problems identified as being *unique* to the printing on *edible paper* placed on a substrate and having desirable characteristics for decorating iced cakes. Stewart explains in connection with printing on edible paper:

In this regard, a conventional printer typically includes a driven roller and a tension roller array which cooperate to grip the paper therebetween and propel the paper lengthwise through the paper path. The tension roller array typically includes a plurality of tension rollers spaced across the width of the paper path. The tension roller array also typically includes one or more bias mechanisms, such as springs, which independently or collectively urge the tension rollers toward the driven rollers. The outboard-most tension rollers will engage the lateral peripheral edges of the paper, while the remaining or center tension rollers are to engage the central portion of the paper. When edible paper is the media to be transported through the paper path, impingement thereof by the center rollers (as brought about due to the bias mechanisms) is determined to be a major cause of damage or distortion of the paper. ***To this end, and in accordance with the principles of the present invention, the printer is modified such that one or more of the central tension rollers do not adversely impinge the edible paper.*** Such a modification can be accomplished either directly, such as by removal of the desired central tension roller(s), or indirectly, such as by overcoming or removing the bias mechanism(s) associated with the desired central tension roller(s). At least one, if not both, of the outboard rollers and associated bias mechanisms, are, however, left in place so as to propel the paper along the paper path by impingement along the peripheral lateral edge(s) of the paper, but with little or no impingement of the central surface of the edible paper.

Stewart at column 2, lines 20-48 (emphasis added). Therefore, Stewart is only concerned with impinging *edible* sheet portion 16, which can be easily damaged or dislodged due to its unique characteristics. Applicant further notes that each of the claims requires the use of edible paper.

On the other hand, Stewart is entirely *silent* about any problems encountered by having the tension roller array gripping the central portion of the *label sheets* disclosed in either Popat reference. Clearly, one skilled in the art would not go through the trouble of removing the center rollers in order to print on the label sheets of the Popat patents, since there is no disclosed advantage to justify this modification with respect to these sheets. To the contrary, it could conceivably result in inferior conveyance of the label sheet through the printer that was originally designed to grip the paper across its entire width.

Moreover, as amended, claim 17 is further distinguishable over the applied art. None of the applied references teach the arrangement of the intermittent and continuous cut lines in combination as recited in claim 17 in combination with the remaining features of that claim. Popat '837 refers to substantially cut lines and through cut lines, neither of which is an intermittent cut line. Popat '837 emphasizes that substantially cut lines and through cut lines is preferred over microperforations as shown in Fig. 2 of the reference. Indeed, even Bishop et al. fails to disclose this feature, but instead discloses that cut lines in *both* directions are perforation lines (*see* column 4, lines 20-27). The additional feature recited in claim 17 is advantageous in that it prevents a printing portion from being detached while the printing paper is conveyed and provides high detachability and an eye-pleasing appearance of the printing portion after being torn.

In view of the foregoing differences, the Examiner is kindly requested to reconsider and allow claim 17 and its dependent claims.

Additionally, with respect to claim 27, the Examiner states:

[I]nsofar as this step is broadly recited, the applicant should note that Figure 4 of the primary reference Popat teaches identical images that traverse several of the intermittent cut lines, which is enough to meet the requirements of this claim..

Office Action at page 4. Applicant disagrees.

While Fig. 4 of Popat '837 discloses multiple images (indicia), each image is printed *within* the perforations. Therefore, the reference does not teach or suggest printing and image “such that the printed image *traverses* at least one of the intermittent cut line and the continuous cut line. More specifically, as with Popat '683, Popat '837 *suggests* that printing an image that traverses a weakened portion would result in a substantially non-functional finished product. Therefore, the Popat references teach away from printing an image that traverses the weakened portion of a printing paper.

Also, with respect to claim 29, the Examiner states that “the primary reference Popat teaches paper stock which is inherently configured for use with a sublimation type heat transfer recording device.” Office Action at page 4. Applicant, again, disagrees.

The Examiner has not pointed to any disclosure in support of his position regarding inherency. Moreover, even if Popat did disclose paper stock which is inherently configured for use with a sublimation type heat transfer recording device, the Examiner cannot reconcile the fact that Stewart clearly *teaches away* from such printer, which cannot be used to print on edible paper. *The applied references must be considered as a whole*, and the Examiner cannot selectively lift a single feature from one reference to the exclusion of the remaining teachings of that reference.

*2. Claim 18 In View Of Popat '837, Stewart, And Shingu et al.*

In rejecting claim 18 in view of Popat '837 in view of Stewart and Shingu et al. the grounds of rejection state:

As outlined in the above rejections, Popat and Stewart teach all the claimed steps, including the step of providing a printing paper with a printing material, a base material, an adhesive layer, as illustrated in Figure 4. In fact, Popat and Stewart teach all the claimed steps except for setting a predetermined value for the sum of a thickness of printing paper, and the setting of a predetermined value for nipping pressure at which margins are nipped by the conveying device. Shingu et al. teaches a web-conveying device that conveys a web in a similar manner as taught by Popat. Shingu et al. teaches in column 12 lines 63, the setting of predetermined nipping pressure for predetermined thickness of sheets. To one of ordinary skill in the art, it would have been obvious to use predetermined values as taught by Shingu et al., in the process of Popat in view of Stewart, in order to have different nip pressures based on different thickness, as taught by Shingu et al. in column 12 lines 63-65.

Office Action at page 4. Without substantively commenting on the grounds of rejection, Applicant submits that claim 18 is allowable at least by reason of its dependency.

*3. Claims 24 And 26 In View Of Popat '837, Stewart, And Bishop et al.*

Again, claims 24 and 26 are believed to be allowable at least by reason of their respective dependencies.

Furthermore, with respect to claim 26, the grounds of rejection state:

Popat in view of Stewart teaches all the claimed steps except for a second printing paper comprising a base material and an adhesive as outlined. Bishop et al. teaches the use of a plurality of the sheets illustrated in Figure 2. Each additional sheet meets the Application/Control Number: 10/073 984 requirements of a second sheet as outlined. As stated above, to one of ordinary skill in the art, it would have been obvious to use the sheet material of

Bishop et al., as a receiver in the method of Popat in view of Stewart, in order to provide sheet stock which may easily be used to produce business cards, party invitations, and file cards.

Office Action at page 6. Applicant respectfully disagrees.

In rejecting claim 26, the Examiner ignores an important limitation that Applicant explained in its last response. Claim 26 requires a substantially equal constant overall thickness for *both* first and second printing papers, *with at least two layers of the first printing paper each having a substantially different thickness from the corresponding layers of the second printing paper*, regardless of the printing application. Providing a substantially equal overall thickness ensures that the nipping pressure on the printing papers remains constant. As a result, the printing papers are smoothly and reliably conveyed. See Applicant's Specification at page 13. This relative difference in *layer* thickness also provides the distinct advantage that one printing paper may provide prints that are thin, non-bulky and easy to carry, while the other printing paper may provide prints that are thick, strong, and less likely to be damaged. See Applicant's Specification at page 14.

Bishop et al. is *silent* with respect to the provision of multiple stocks of recording material, each having three layers and an *overall same thickness*, with at least two layers in one stock having *different thicknesses* from the corresponding layers in the other stock. Rather, Bishop et al. merely sets a *range* for the overall thickness of a composite sheet, but makes no disclosure of having sheets of different stock with the same overall thickness and different layer thicknesses.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the




AMENDMENT UNDER 37 C.F.R. § 1.116  
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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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